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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,536	03/29/2005	Yasuhito Yuasa	10873.1640USWO	4552

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

MAIL DATE	DELIVERY MODE
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07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,536

Applicant(s)

YUASA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/29/05 5/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 24 February 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the change in the wax from polypropylene to polyethylene is without basis in the specification as filed and applicants have not provided evidence to show that the tradename material specified in Table 2 has is actually a polyethylene wax. Lacking evidence, the amendment is seen as containing new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Information Disclosure Statement

The information disclosure statement filed 27 May 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered for the document(s) failing to meet this requirement.

Claim Objections

Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or

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rewrite the claim(s) in independent form. Claims 5 and 6 specify that the toner contains a wax in specified amount, but base claim 1 and dependent claims 5 and 6 require only a carrier. The toner of claim 1 is not a material requirement of the claim – only a carrier is required. As such, specifying materials of the toner does not change the characteristics of the carrier. Claims 5 and 6 fail to further limit claim 1 as now presented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-8, and 11 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Kobayashi *et al.* in US Patent Application Publication 2003/0091923.

In the instant claims the toner is not a material limitation on the carrier because the claim preamble limits the scope of protection to only the carrier. The toner is not present in the carrier and would be a separate component, such as if in a two-component developer.

Kobayashi discloses a carrier having a core with a coating resin layer on its surface (Abstract; ¶ [0025]). The coating resin layer contains an aminosilane in an amount of from 2 to 60 weight percent based on the solids content of the coating and a fluorine-modified silicone resin (¶¶ [0029] – [0033]). As seen in the general formula, halogen groups (e.g., the specified

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fluorine) are present on the crosslinked silicone (§ [0033]). The exemplified carrier of Example 3 contains 23.1 weight percent of aminosilane based on the solids content (i.e., $36/(36+120)$). The coating resin layer also contains conductive particles in an amount of 0.5 to 6 weight percent (§ [0027]; Example 3). The disclosure of the specific amount of the aminosilane in the coating resin layer in Example 3 combined with the specific disclosure of a fluorine-modified silicone resin is seen as sufficient to identically disclose the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi *et al.* in US Patent Application Publication 2003/0091923.

This rejection is applied against claims 1, 2, 4-8, and 11 in the event the disclosure is not sufficient to identically disclose subject matter within the scope of these claims. In such an event, It would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare a carrier having the amount of the aminosilane specified in Example 3 and a fluorine-modified silicone resin in the carrier resin coat layer because each of these components is disclosed as effective in the resin coat layer and the artisan would combine specifically disclosed components to obtain the reduced environmental dependence on charge discussed in § [0018]. With respect to claims 9 and 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to produce a silicone

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according to the formula given in ¶ [0031] and perfluoroalkyl units given in ¶ [0033] in order to reduce wear on the carrier particles (¶ [0031]). The artisan would have found it obvious to optimize the amounts of these components to obtain these benefits (see pending claim 10).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/
Primary Examiner
Art Unit 1756

cdr
19 July 2007